

MAIL STOP AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: F.D. Griss Attorney Docket No.: GRISF122500
Application No.: 10/828/943 Group Art Unit: 3643
Filed: April 21, 2004 Examiner: D.J. Parsley
Title: BAIT HOLDER FOR A FISHING LURE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Seattle, Washington 98101

October 25, 2005

TO THE COMMISSIONER FOR PATENTS:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

ARGUMENTS

Rejection of Claims 1 and 9 Under 35 U.S.C. § 102(b) as Being Anticipated by Hughs U.S. Patent No. 4,307,532.

Applicant respectfully submits that the Examiner has misunderstood and mischaracterized the disclosure of the Hughs '532 patent in rejecting Claims 1 and 9 and that this reference does not disclose each and every one of the claimed elements as would be required to find anticipation under 35 U.S.C. § 102.

Claim 1 recites a linear shaft connected at one end to a hook and at the other end to a leader. A tube covers the shaft and is adapted to hold a bait such as a piece of herring wrapped therearound and held in place by a wire wrapped around the bait. The Hughs patent does not disclose a shaft but rather discloses a conventional flexible leader 1 which is adapted to be

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

wrapped noose-like around a bait. Hughs does not disclose a tube on which a bait is mounted nor a wire wrapped around the bait mounted on the tube.

With respect to Claim 9, Hughs does not disclose a wire wrapped around a bait in a spiral toward a hook to hold the bait on a tube.

Rejection of Claim 12 Under Section 102(b) as Being Anticipated by U.S. Patent No. 2,982,049 to Yost or U.S. Patent No. 3,839,851 to Latham.

Applicant respectfully submits that the Examiner has mischaracterized both the Yost and Latham patents and that they do not disclose each and every element of Claim 12. Yost discloses a loop formed of thin monofilament leader material adapted to hold live bait to a fishhook. The Yost device is significantly different in its purpose and structure from Applicant's claimed fishing lure wherein a bait is held by a wire on the surface of a tube not on a fishhook.

Latham U.S. Patent No. 3,839,815 discloses a shaft 24, whose purpose is to pierce a bait. A hook and related spring element resiliently holds the bait in place on the wire 24. Latham does not disclose a tube mounted on a shaft having a surface on which bait is mounted and held by a wire wrapped therearound.

Rejection of Claims 2-3 and 5-6 Under 35 U.S.C. § 103 Over Hughs in View of Richardson U.S. Patent No. 5,881,490.

The Examiner has taken the position that the Richardson '490 patent discloses use of a metal wire to wrap a bait to hold it in place on a tube. In fact, the metal wire 34 disclosed in Richardson is used only to keep the mouth of the bait fish closed so that it is not deformed when it is pulled through the water (see, Col. 3, lines 6-12). As stated earlier, Hughs itself does not disclose a shaft covered by a tube on which a bait is mounted.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

Rejection of Claim 3 Over Hughs in View of Richardson.

Applicant claims a specific gauge range for the wire which it uses to hold a bait in place on a tube. Richardson does not disclose the same gauge of wire nor does it disclose using the wire for the same purpose. Therefore, there is no teaching to combine and it would not be obvious to modify Hughs in view of Richardson in view of a different gauge wire than disclosed in Richardson.

Rejection of Claim 5 Over Hughs in View of Richardson.

The Examiner asserts that Richardson discloses a stainless steel shaft 12. In fact, all Richardson discloses is a flexible wire leader not a linear shaft having a tube thereon around which a bait can be wrapped.

Rejection of Claim 6 Over Hughs as Modified by Richardson.

Since as set forth above, neither Hughs nor Richardson disclose a linear stainless steel shaft adapted to hold a tube around which a bait may be mounted and held, the combination of claimed elements is not found or suggested. Further, these references do not disclose a shaft of the particular claimed diameters.

Rejection of Claim 4 Over Richardson, or Yost as Modified by Richardson, in View of Hinkson, U.S. Patent No. 3,293,791.

Hinkson is particularly concerned with an apparatus insertable into the mouth end of the bait fish to stiffen and shape it. Col.1, lines 7-12. Hinkson discloses a conventional leader passing through a plastic tube which protects the leader from being bitten through by predatory fish. Column 3, lines 26-29. Hinkson does not disclose a shaft on which bait is adapted to be wrapped and held in place by a flexible wire and the combination with Richardson and Yost would not produce the claimed invention.

Rejection of Claim 7 Over Hughs in View of Brimmer, U.S. Patent No. 4,691,467.

Brimmer discloses a way of holding a bait on a fishhook shaft with a rubber band extending out of a piece of plastic, heat-shrunk to the fishhook shank. The Examiner argues that it would have been obvious to heat-shrink a piece of plastic to the leader 1 of Hughs. There is no teaching of such a combination in any of these references and the end result would be unworkable since the Hughs reference is designed to hold a live bait fish in the loop 3 not on the shaft 1. The Examiner's combination is pure hindsight speculation.

Rejection of Claims 10 and 11 Over Hughs in View of Mantel.

Claims 10 and 11 do not assert that blades are in any way novel *per se* and thus, the fact that Mantel discloses a blade is irrelevant since Hughs does not disclose the rest of applicant's structure as set forth above.

Rejection of Claim 12 Over Hughs in View of Richardson.

Neither Hughs nor Richardson taken singly or together disclose a linear wire on which a tube is mounted which is adapted to receive a piece of bait wrapped thereover and held in place by a wire. The wire 34 of Richardson is merely designed to keep a bait fish's mouth closed.

SUMMARY

In the first Office Action in this case, applicant's claims were principally rejected over Great Britain Patent No. 2,355,636 to Hancock, et al. Applicant pointed out to the Examiner why Hancock did not anticipate or make obvious the claimed invention and in a second Office Action, applicant's claims were principally rejected over new references Yost and Richardson discussed above.

After phone conversations with the Examiner, applicant made minor amendments to certain of the claims which lead to the current final rejection principally over the newly cited Hughs patent alone or combined with the other art discussed above, none of which is particularly

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

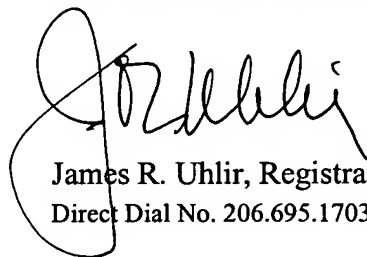
close to applicant's claimed invention. The continued rejections of allowable claims over new art which is different but no more relevant than the previously cited art was improper and frustrated applicant's attempts to work out allowable claim language since the cited prior art was a continually moving target.

CONCLUSION

Applicant submits that its claims are neither anticipated nor made obvious by any of the art found by the Examiner and applicant requests that the rejection of Claims 1-7 and 9-12 should be withdrawn and the application passed to issued.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



James R. Uhler, Registration No. 25,096
Direct Dial No. 206.695.1703

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date:

October 25, 2004



JRU/cjd

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100